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CENTRAL FAX CENTER
JUN 14 2007

Application No. 10/797,098
Amendment dated June 14, 2007
Reply to Office Action of March 14, 2007

Docket No.: 2519-0297PUS1

REMARKS

Claims 1-15 remain present in this application.

The specification and claims 1, 6-7 and 9 have been amended. Reconsideration of the application, as amended, is respectfully requested.

Priority Claim

The Examiner has acknowledged the certified copy of the priority document, without acknowledging the claim for foreign priority itself. Instead, the Examiner has indicated that, "If this copy is being filed to obtain the benefits of the foreign filing date under 35 U.S.C. 119(a)-(d), applicant should also file a claim for such priority as required by 35 U.S.C. 119(b)."

In this regard, it is noted that the claim for foreign priority was explicitly set forth in the Declaration filed on March 11, 2004. The Examiner's attention is drawn to the bottom section of the Declaration, which states, "I hereby claim foreign priority benefits under 35 U.S.C. 119(a)-(d)... listed below..." Below this text, Taiwan Application No. 092122314, filed August 13, 2003, is listed. Accordingly, the inclusion of this information on the Declaration should be considered a claim for foreign priority under 35 USC 119, in compliance with 37 CFR 1.55(a)(1), as the claim clearly identifies "the foreign application for which priority is claimed,... by specifying the application number, country ... day, month, and year of its filing."

In support of the claim for foreign priority, a certified copy of the priority document was submitted on April 4, 2005.

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Accordingly, it is respectfully submitted that a claim for foreign priority has been properly set forth, and that the Examiner should acknowledge both the claim for priority under 37 CFR 1.119, and the certified copy of the priority document.

Objection to the Claims

The claims stand objected to for certain informalities. In view of the foregoing amendments, it is respectfully submitted that these informalities have been addressed. Accordingly, reconsideration and withdrawal of any objection to the claims are respectfully requested.

Rejection under 35 USC 112

Claims 6 and 7 stand rejected under 35 USC 112, second paragraph. This rejection is respectfully traversed.

In view of the foregoing amendments, it is respectfully submitted that all claims particularly point out and distinctly claim the subject matter of the instant invention. Accordingly, reconsideration and withdrawal of the 35 USC 112, second paragraph rejection are respectfully requested.

Rejection under 35 USC 102

Claims 1-15 stand rejected under 35 USC 102(e) as being anticipated by Nakano et al., U.S. Publication 2004/0100479. This rejection is respectfully traversed.

"A claim is anticipated only if each and every element as set forth in the claim is

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found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). (MPEP §2131)

Independent claims 1 and 9 of the present application define a method to process a multifunctional menu of a human input device and a human input system respectively, in which the first switching icon is used for switching to the auto-scroll menu.

With particular reference to Nakano, the purpose of the prior art is related to a display control method, and Nakano fails to teach the same first icon as is set forth in independent claims 1 and 9 of the present application.

Referring to paragraph [0010] of Nakano, this patent teaches that an icon is selected from a menu screen where icons are arranged, and the selected icon is gradually scaled up and gradually turns fainter to perform switchover to the information screen. With respect to the International Publication WO 00/33571, to which paragraph [0010] of Nakano refers, this document teaches that the information screen is the sub-menu of the menu screen. However, unlike Nakano and the WO '571 document, the first switching icon of the present application is used for switching to the auto-scroll menu.

In addition, MPEP §2121.01 also provides:

The disclosure in an assertedly anticipating reference must provide an enabling disclosure of the desired subject matter; mere naming or description of the subject matter is insufficient, if it cannot be produced without undue experimentation. ... A reference contains an "enabling

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disclosure" if the public was in possession of the claimed invention before the date of invention. "Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his [or her] own knowledge to make the claimed invention." *In re Donohue*, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985). (MPEP §2121.01)

In other words, although the Examiner asserts that the auto-scroll menu has been disclosed in paragraphs [0006] and [0007] and the abstract of Nakano, Nakano fails to discloses how the information screen turns into the scroll operation in the portions cited by the Examiner. Nakano therefore does not contain an enabling disclosure. Because the Examiner's rejection is unsupported by the art, it should be withdrawn.

Furthermore, the menu of the present application is displayed in a popup mode according to said predetermined pressing signal. However, in Nakano, the menu is directly displayed on the screen without the predetermined pressing signal.

In view of the foregoing amendments and remarks, it is respectfully submitted that the prior art utilized by the Examiner fails to teach or suggest the method or system of independent claims 1 and 9, as well as their dependent claims. Accordingly, reconsideration and withdrawal of the 35 USC 102(e) rejection are respectfully requested.

Conclusion

Favorable reconsideration and an early Notice of Allowance are earnestly solicited.

Because the additional prior art cited by the Examiner has been included merely to show the state of the prior art and has not been utilized to reject the claims, no further comments concerning these documents are considered necessary at this time.

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In the event that any outstanding matters remain in this application, the Examiner is invited to contact the undersigned at (703) 205-8000 in the Washington, D.C. area.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: June 14, 2007

Respectfully submitted,

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